

Application No.: 09/890,784

Docket No.: 21499-00049-US

REMARKS

Reconsideration of claims 1-20, and consideration of new claims 21-30 is respectfully requested.

The rejection of claims 1-20 under 35 U.S.C. §112, second paragraph as stated in paragraphs 2 through 6 under the sub-heading "Claim Rejections -35 U.S.C. §112" is respectfully traversed with respect to the amended claims. Claims 1-20 were amended to conform to proper U.S. claim format. For example, the claims have been amended to remove the phrase "characterized in that" and the range within a range language. Claims 12-15 were amended to clearly state what the polymer dispersion can be used for.

The rejection of claims 1 and 8-15 under 35 U.S.C. §102 (b) as being anticipated by Degan, U.S. 4,835,212 (referred to hereinafter as the '212 patent) is respectfully traversed with respect to the amended claims. The Office Action correctly states that the aqueous polymer dispersion described in the '212 patent comprises "starch and monomers", particularly ethylenically unsaturated monomers. Col. 1, line 67 to Col. 2, line 19. Applicants also agree that the Table in Col. 6 describes "3 types of starches", and that "Starch III is a cationic potato starch, having intrinsic viscosity of 1.16". However, the intrinsic viscosities listed in the Table, refers to the intrinsic viscosities prior to the additional enzymatic and oxidative degradation described in the '212 patent. In other words, the '212 patent describes that one can start with Starch III, but before one adds the monomers to Starch III, one must further degrade Starch III. See, col. 2, lines 16-18; col. 3, lines 23-47; Example 1-6 and Comparative Examples 1-3 and 6. The Table below summarizes the intrinsic viscosities of the starches used in Examples 1-6 prior to forming a polymer dispersion, i.e., prior to combining with the unsaturated monomers. As described in the '212 patent and in all of the examples, the intrinsic viscosity of the starch is always less than 0.08 before combining with the monomers.

<u>Example</u>	η_i dl/g
1. (Starch I)	0.058
2. (Starch I)	0.06
3. (Starch II)	0.045
4. (Starch IV)	0.052
5. (Starch II)	0.08
6. (Starch II)	0.07

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At no time, does the '212 patent describe a *polymer dispersion* that contains a starch "having an intrinsic viscosity of greater than 1.0 dl/g" as claimed. Accordingly, Applicants respectfully request that the rejection be withdrawn.

The rejection of claims 1 and 8-15 under 35 USC §102 (b) as being anticipated by Degan (US 4,855,343) is respectfully traversed with respect to the amended claims. For the same reasons provided above, Applicant's respectfully request that the rejection be withdrawn.

The rejection of claims 1-6, 8, and 10-20 under 35 USC 102(e) as being anticipated by Konig (WO 99/42490) is respectfully traversed. Konig has an international filing date of February 6, 1999, and a corresponding §371(c)(i)(2) and (4) date of August 11, 2000. A reference based on an international application that was filed prior to November 29, 2000 is subject to the pre-AIPA version of 35 USC 102(e).

Under the pre-AIPA version of § 102(e) "a person is entitled to a patent unless the invention was described in a patent granted on an ...international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c)...before the invention thereof by the Applicant." With respect to Konig's international application, the Examiner must rely on the 371(c) date, and not the international filing date. Because the Applicants' international filing of February 7, 2000 precedes the 371(c) date, Applicants respectfully request that the rejection under 102(e) be withdrawn.

Given the 103(a) rejection is incorrectly based on Konig as a reference under §102(e). Applicants respectfully request the rejection be withdrawn. In fact, even if Konig could be applied, like the two Degan references, Konig describes use of a degraded starch having Mw of 500 to 10,000. Starches with a molecular weight in this range will certainly not have an intrinsic viscosity of greater than 1.0 dl/g, as claimed.

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In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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Respectfully submitted,

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